

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
GROUP ART UNIT 1753**

EXAMINER: Edna Wong
APPELLANT: Paskalov et al.
SERIAL NO: 10/698,867
FILED: 10/30/2003
FOR: High Energy Disinfection of Waste

Commissioner of Patents and Trademarks
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

APPELLANT'S REPLY BRIEF UNDER 37 CFR §41.37

This reply brief is file in response to the Examiner's Answer filed December 4, 2007. The Applicant respectfully requests that the appeal filed October 29, 2007 be maintained under 37 CFR 41.41.

Old Rejections

A. Rejection Of Claims 12-20 Under 35 U.S.C. §112, First Paragraph, As Failing To Comply With The Written Description Requirement.

The Examiner argued that the limitation "without subjecting the waste directly to the plasma generated by the RF plasma wave generator" lacks literal basis in the specification as originally filed. (See Examiner's Answer, P4). That just isn't so.

First of all, as the Applicant previously stated, literal basis is not the proper test. The proper test for a 35 U.S.C. §112 rejection is whether the specification reasonably conveys to one of ordinary skill in the art that the inventor had possession of the claimed invention as of the filing date. *See In re Kaslow*, 707 F.2d 1366 (Fed. Cir. 1983) ("The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.")

Secondly, there is support in both the current specification and the parent application, which is incorporated by reference, that show the plasma in a closed system that subjects the

waste directly to the waves produced by the RF plasma generator without subjecting the waste directly to the plasma generated by the RF plasma wave generator. (See current specification, P4/L22 – P5/L27 and corresponding Figure 1, and parent specification para [0019]-[0020] and corresponding Figure 1).

B. Rejection of claims 15-17 and 20 under 35 U.S.C. 112, second paragraph

The Examiner argued that the relationship between the limitation “treating the waste at a rate of at least 20 l/hr” and the limitation of “conditions” is unclear.

Here again the Examiner is applying the wrong test. The test for definiteness under 35 U.S.C. 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). That test is satisfied. The limitation is explained in detail on P4/L22-P5/L3 of the current specification.

It is unclear why the examiner keeps applying the wrong test, and why, if another test is being argued, the examiner fails to provide support for that other test.

New Rejections

On page 6 of the Examiner’s Answer, the Examiner brought up new grounds of rejection. However, according to 37 CFR 41.43(a)(2), “A supplemental examiner’s answer responding to a reply brief may not include a new ground of rejection.” (See MPEP 1207.05) The new grounds of rejection are thus improper and should be ignored.

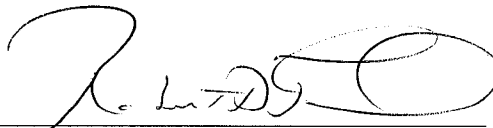
Nor would it be proper for the Examiner in this case, after having forced the Applicant to spend the time and money appealing invalid rejections, to withdraw the matter from appeal. The reason is that these “new” grounds of rejection were already presented by the Examiner in the Office Action dated March 26, 2007, and were already withdrawn in the Examiner’s Office Action dated August 8, 2007.

CONCLUSION

The pending claims are all allowable as written. The Examiner is being overly pedantic in applying 35 U.S.C. 112, is ignoring the applicable case law, is creating her own spurious

interpretations of the law, is ignoring clearly referenced portions of the specification, and is now even casting old rejections as "new" in her answer. The rejections should be over-ruled.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. D. Fish', written over a horizontal line.

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